

REMARKS

Claims ~~1, 2, 4, 5, 10, 11, 13, 14, 19, and 20~~ currently pending in the subject application, and are presently under consideration. Claim 20 has been amended herein. A clean copy of all pending claims is found at pages 2-5 of this Reply. A marked up version of the amended claim is found at page 10 of this Reply. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendment herein.

**I. Rejection of Claims 1, 2, 4, 5, 10, 11, 13, 14, 19, and 20 Under 35 U.S.C. §102(b)**

Claims 1, 2, 4, 5, 10, 11, 13, 14, 19, and 20 stand rejected under 35 U.S.C. 102(b) as being anticipated by Piber (U.S. Pat. 4,082,934). It is respectfully requested that this rejection be withdrawn for at least the following reasons.

Piber does not teach or suggest at least one elongated strip of substantially translucent material extending through the first side and at least one of second and third sides so that part of the strip is visible at the first side and the at least one of the second and third sides through which the strip extends, as recited in claim 1. Instead, Piber teaches an insert that extends through a single end of a flattened tunnel, which extends longitudinally vertically through an operating handle. The insert projects beyond the outer end of the handle such that the head portion of the insert forms the outer tip of the handle. The inner flat end of the insert, although it projects beyond the tunnel at the other end, remains in the interior of the housing. Col. 3, lines 19-42. Thus, as shown in Figs. 2 and 4 of the Piber patent, the insert extends through a tunnel formed in a handle, but does not extend through a first side of the housing and at least one of a second and third side of the housing so as be visible from the sides through which it also extends.

*Assuming arguendo* that the ends of the tunnel are considered a first and second side of the housing, the insert is only visible at the first side. The second side terminates inside the handle; and although the insert extends through the tunnel, this end of the insert remains in the interior of the operating handle and thus, is not visible. Therefore, since Piber does not teach or suggest each and every element as set forth in claim 1, Piber does not anticipate claim 1. Accordingly, withdrawal of this rejection and allowance of claim 1 and claims 2, 4, 5, and 10, which depend therefrom, are respectfully requested.

With respect to claim 4, Piber does not teach or suggest at least one elongated strip which extends completely through the housing from the second side through to the third side

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and is exposed at the first side, whereby the at least one elongated strip is visible along the first side, the second side, and the third side. Rather, Piber teaches an insert which extends through one end of an operating handle. Although the insert taught in Piber is visible from the sides of the handle, the insert does not extend through these sides.

Regarding claim 11, for the reasons stated above, it is respectfully submitted that Piber does not teach or suggest an elongated slot formed in a housing extending through the first and at least one of the second and third sides of the housing, and a substantially translucent material being disposed in the slot and being visible at the first side and the at least one of the second and third sides. Although Piber teaches an insert, which extends through a tunnel formed within an operating handle, the insert does not extend through a first *and* at least one of the second and third sides of the handle. Furthermore, the insert is not visible at both sides of the tunnel, since one side is disposed within the interior of the handle. Thus, since Piber does not teach or suggest each and every element as set forth in claim 11, Piber does not anticipate claim 11. Accordingly, withdrawal of this rejection and allowance of claim 11 and claims 13, 14, and 19, which depend therefrom, are respectfully requested.

Claim 20 has been amended to recite that the translucent means extends through a plurality of sides of a sidewall of housing means. Piber does not teach or suggest a substantially translucent means extending through a plurality of sides of the sidewall portion of the housing means, as recited in amended claim 20, similar to the reasons stated above with respect to claims 1 and 11.

For these reasons, withdrawal of this rejection and allowance of independent claims 1, 11, and 20 and their dependent claims 2, 4, 5, 10, 13, 14, and 19 are respectfully requested.

## **II. Rejection of Claims 3, 6-9, 12, and 15-18 Under 35 U.S.C. §103(a)**

Claims 3, 6-9, 12, and 15-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Piber in view of Duerkob (U.S. Pat. 4,954,808). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Claims 3, 6-9 and 12, and 15-18 directly or indirectly depend from independent claims 1 and 11, respectively. Duerkob does not make up for the aforementioned deficiencies of Piber with respect to claims 1 and 11. Therefore, claims 3, 6-9, 12, and 15-18 are not obvious over the combination of Piber and Duerkob.

Moreover, to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Piber is directed to illuminated electric switches having a pivotal operating handle, such as tab switches, toggle lever switches, rocker switches, etc, while Duerkob is directed to a lighted turn and stop signal for rear mounted, eye level use on an inside shelf of an automobile. Thus, Piber and Duerkob cannot be combined to make the present invention obvious because there is no suggestion or motivation in either reference to combine the reference teachings.

Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the cited art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Piber does not teach or suggest the light source having an illuminated condition and non-illuminated condition, each condition being indicative of an operating condition of the indicator apparatus, as recited in claim 3, nor does it refer to any problem that would suggest to one of ordinary skill in the art to use such an indicator.

Likewise, Piber does not refer to or suggest any problem that would suggest to one of ordinary skill in the art to use a substantially opaque material as a partition to separate at least two elongated strips of substantially translucent material, as recited in claim 6, nor to include a different light source operatively associated with each of the at least two elongated strips so that light from each source illuminates a corresponding one of the at least two elongated strips, as recited in claim 7. It is respectfully submitted, that the suggested combination to employ a substantially opaque partition between strips of translucent material, as recited in claims 6 and 7 appears to be based on improper hindsight, in which the present application provides the teaching and motivation to do so. For example, why would one of ordinary skill in the art desire to employ more than one lighted end cap in a switch (according to Piber), which are separated by partitions (according to Duekerob)? Neither Piber nor Dukerob contain a teaching or suggestion that would provide proper motivation to combine the teachings to create the subject matter of claim 6 or claim 7, which depends from claim 6.

Accordingly, withdrawal of this rejection and allowance of claims 3, 6-9, 12, and 15-18 are respectfully requested.

### **III. Rejection of Claim 21 Under 35 U.S.C. §103(a)**

Claim 21 stands rejected under 35 U.S.C. as being unpatentable over Piber in view of Schneider *et al.* (U.S. Pat. Des. 391,182). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Piber and Schneider cannot be combined to make claim 21 obvious because there is not proper motivation in either reference to combine the reference teachings. "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Piber is directed to illuminated electric switches and the problems associated with such switches, such as the intensity of the illumination, the difficulties of relamping, and interchangeability of the operating handle. Thus, Piber does not refer to any problem that would suggest to one of ordinary skill in the art to use a proximity switch in combination with the illuminated electric switch of Piber. Likewise, the teachings of Piber would not suggest to one of ordinary skill in the art to use a proximity switch in combination with the illuminated electric switch, as taught in Piber. Accordingly, withdrawal of this rejection and allowance of claim 21 are respectfully requested.

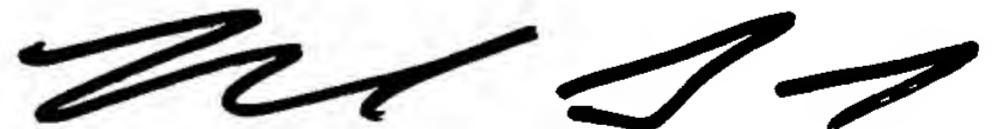
#### IV. Conclusion

The present application is believed to be condition for allowance in view of the above comments and amendment.

If any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,  
AMIN & TUROCY, LLP

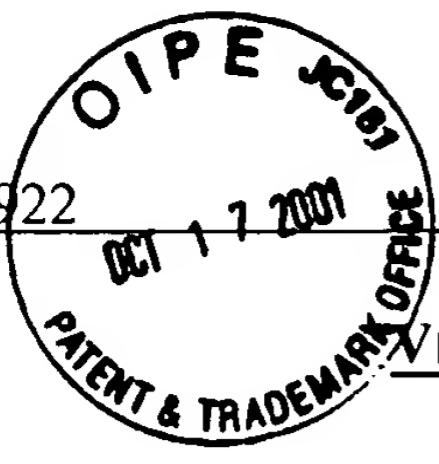


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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the claims:

Please amend claim 20 as follows:

20. (Amended) An indicator apparatus, comprising:  
housing means having an outer sidewall portion;  
illumination means for, when activated, emitting light; and  
substantially translucent means extending through a plurality of sides of the sidewall  
portion of the housing means for transmitting emitted light from the illumination means so as to  
be visible from [a] the plurality of sides of the outer sidewall portion of the housing.

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